

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**CERTIFICATE OF MAILING**

I certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on June 24, 2003.

Marta I. Burgin  
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In the Matter of Application  
Serial No. 78/081,731 published in the  
Official Gazette on  
July 16, 2002 at TM 935



06-26-2003

U.S. Patent & TMO's/TM Mail Rpt Dt. #22

**THE CHAMBER OF COMMERCE  
OF THE UNITED STATES OF AMERICA**

**Opposer,**

v.

**UNITED STATES HISPANIC  
CHAMBER OF COMMERCE  
FOUNDATION,**

**Applicant.**

Opposition No. 91156321

*Fees for counterclaims*

Applicant UNITED STATES HISPANIC CHAMBER OF COMMERCE

FOUNDATION, for its Answer to Opposer THE CHAMBER OF COMMERCE OF THE  
UNITED STATES OF AMERICA's Notice of Opposition, states:

I.1. Applicant admits that the records of the Patent & Trademark Office reflect the registration numbers as set forth in Paragraph I.1 and that the registration speaks for itself as to ownership of the registrations and the services for which each mark is registered.

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05/06/2004 JBR00KS1 00000088 012384 1686865

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05/06/2004 JBR00KS1 00000089 012384 1522157

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OF COMMERCE and the design mark at issue, has actively misrepresented that it would not assert a right or claim against Applicant. This delay is not excusable and has caused Applicant undue prejudice since Applicant has built a considerable amount of goodwill in UNITED STATES HISPANIC CHAMBER OF COMMERCE and the design mark at issue and has spent a considerable amount of monetary resources to promote these marks. Given the Applicant and Opposer's long-time co-existence in close proximity of each other, Applicant notes this is an exceptional case and respectfully requests that the Board considers this defense as it relates to Applicant's use of its mark.

### **COUNTERCLAIMS**

Applicant asserts the following counterclaim:

#### **PETITION FOR CANCELLATION**

In the matter of Registration No. 1,686,865; Registration No. 1,522,157; Registration No. 1,436,813 and Registration No. 1,430,627 issued to Opposer, Applicant deems itself injured by these registrations and hereby applies for cancellation thereof.

For its Petition for Cancellation against Opposer, Applicant states as follows:

1. Applicant is a Washington, D.C. not-for-profit corporation foundation with its principal place of business in Washington, D.C..

7. Opposer's registrations have and will continue to harm Applicant because the registration of these generic terms, with naught to distinguish them, makes it impossible for Applicant and others to use these generic terms for their chamber of commerce services.

8. Applicant authorizes the United States Patent and Trademark Office to charge Armstrong Teasdale LLP's Deposit Account No. 01-2384 with respect to the necessary statutory fee.

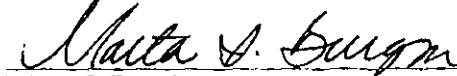
WHEREFORE, Applicant prays that Registration No. 1,686,865; Registration No. 1,522,157; Registration No. 1,436,813 and Registration No. 1,430,627 be cancelled.

#### CONCLUSION

WHEREFORE, Applicant respectfully prays that Opposer's Opposition be dismissed, that Opposer's registrations be cancelled, and that Applicant's application for registration be allowed to proceed.

RESPECTFULLY SUBMITTED,

ARMSTRONG TEASDALE LLP



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